

## **REMARKS**

This communication is in response to the final Office Action issued July 12, 2004. The Examiner rejected claims 19-26 under 35 U.S.C. § 102 in view of U.S. Patent No. 5,421,098 to Muldoon (Muldoon).

### Information Disclosure Statement

On August 21, 2003, the Applicants submitted an Information Disclosure Statement (IDS) and Form PTO-1449 disclosing 18 references. Since all of the disclosed references were of record in the parent application, no copies of the references were required and none were provided.

In the March 4, 2004 Office Action, the Examiner objected to the IDS. The Examiner stated that the IDS was noncompliant because copies of the cited references were not provided. The Examiner returned a copy of the Form PTO-1449 indicating that 7 references were not considered. The Applicant responded on June 2, 2004 by pointing out that pursuant to 37 CFR 1.98(d), no copies of the references were required.

While the Examiner has withdrawn the objection to the IDS, no initialed copy of the Form PTO-1449 indicating that all of the references were considered has been provided. The Applicant respectfully requests that the Examiner review the cited references and provide an initialed copy of the Form PTO-1449 indicating that all of the references - including the 7 previously not considered by the Examiner - be provided.

### Claim Rejections Under 35 U.S.C. § 102

In sections 1-2 of the Office Action, the Examiner rejected claims 19-26 under 35 U.S.C. § 102 in view of Muldoon.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy this burden.

Independent claim 19 requires *inter alia* that the measurement member be coupled to the carriage in an opposing relation to the clamping member. Having the measurement member opposing the clamping member allows the left-right travel of the measurement member to be unencumbered by the clamping member. See, for example, figure 2. This greatly facilitates measurement of both right-handed and left-handed golf clubs. Since the loft angle is being measured, the face of the club is positioned against the abutment member. The club shaft will extend above and to either the left or right of the fixture, depending on whether the club is right-handed or left-handed. To switch between measuring right-handed and left-handed clubs, the measurement member is simply slid to the appropriate side of the fixture and the cradle rotated to the appropriate side.

In the Office Action, the Examiner stated that Muldoon disclosed "a measurement member 74, 98 ... coupled to said carriage 76 in an opposing relation to said clamping member 73." The Applicant respectfully traverses the Examiner's statement. The Muldoon device does not have the beneficial opposed relationship between the measurement member and the clamping member. Instead, they are both positioned on the same side of the device. See, for example, figure 7. In order to switch between measuring a right-handed and a left-handed golf club, the knob 82 must be removed from the bench, the subassembly 76 must be removed from the bench and repositioned thereon on the opposite side of the clamping subassembly, and the lie

measuring bracket must be removed, inverted, and reattached. See, for example, column 5, line 65 to column 6, line 3.

Thus, Muldoon does not show a measurement member being coupled to the carriage in an opposing relation to the clamping member. For at least this reason, the rejections of the claims are improper and must be withdrawn.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 102 to the claims are believed to be overcome.

Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin Shreff Friedman, LLP Deposit Account No. 19-5127 (order no. 20003.0074).

Conclusion

Claims 19-26 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help

prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



Dated: October 12, 2004

Sean P. O'Hanlon  
Reg. No. 47,252

Swidler Berlin Shreff Friedman, LLP  
3000 K Street, NW  
Suite 300  
Washington, DC 20007  
(202) 295-8429